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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,708	04/10/2001	R. Dennis Nesbitt	P-5686-C1	2621

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11/19/2003

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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/19/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,708

Applicant(s)

NESBITT ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7-11,13-17,19-25,28-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7-9,11,13,15-17,19-21,23,29,32,33 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 10,14,22,28 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The indicated allowability of claims 1, 3, 15, 23, 28-30, and 32 are withdrawn in view of the newly discovered reference(s) to Egashira et al. (USPN 5439227) and Higuchi et al. (USPN 5725442). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 7-11, 13, 14, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 5, and 16 recites "cover having at least one of (i) . . . , and (ii) . . . ". Language implies that the golf ball cover can have both (i) and (ii) at the same time, which is not possible. Furthermore, the specification does not enable the cover have both (i) and (ii) at the same time, therefore, the above claims have been rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7-11, 13, 14, 16, and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, and 16 recite the cover having at least features (i) and (ii), wherein the specification makes clear that the cover may have either features (i) or (ii). Changes to the claim should be made to clarify the invention.

Claim 35 recites "said center component including a thermoset material and said core component including a thermoplastic material". Does the applicant really mean that the center core component includes a thermoset and the core layer component includes a thermoplastic material? For the purpose of examination, claim 35 will be interpreted as the center core component including a thermoset and the core layer component including a thermoplastic material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 8, 9, 11, 13, 15-17, 19-21, 33, 35, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuchi et al. (USPN 5725442).

Higuchi et al. discloses a multi-piece golf ball having good flying performance, durability, and pleasant feel (See Abstract). The ball comprises a core including an inner sphere and one or more surrounding layers and also inner and outer cover layers (See Abstract). The inner sphere is made of preferably polybutadiene, which is acknowledged by the applicant in claims 7 and 9, as a thermoset material, and an inert filler such as zinc oxide (See Column 4, lines 13 through 43). The surrounding layer is formed of an ionomer resin, which is acknowledged as a thermoplastic material by the applicant in claim 11 (See Column 3, lines 63 through 65). The inner sphere also has a diameter of up to 35 and the entire core has a diameter of 30 to 39mm (See Column 3, lines 57 through 62). The inner cover layer has a hardness of up to 57 Shore D and the outer cover layer has a hardness of at least 58 Shore D (See Paragraph bridging Column 2 and 3). The inner and outer cover layers are disclosed as being made of ionomer (See Paragraph bridging Column 4 and 5).

Claims 3, 5, 7-9, 11, 13, 15-17, 19-21, 33, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Egashira et al. (USPN 5439227).

Egashira et al. discloses a multi-piece golf ball having a improved flying performance, feel, and durability (See Abstract). The ball comprises a core that includes an inner layer and outer layer and a cover (See Abstract). The inner layer is formed of polybutadiene and zinc oxide, the outer layer is formed of a polyether ester type thermoplastic elastomer of an ionomer, and the cover is formed of ionomer (See Entire document). The cover also has a hardness of 30 to 55 Shore D (See Column 5, lines 2 through 8). The inner layer has a diameter of 30 to 37mm and the entire core, as

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shown in Table 2, has a diameter of up to 38.8mm. It is also noted that the core may contain three, four or more layers (See Column 3, lines 9 through 21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 24, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (USPN 5725442) in view of Sullivan et al. (USPN 5803831).

Higuchi et al. does not disclose the inner and outer cover layers of ionomer having 16% or greater acid content and/or 16% or less acid content. Sullivan et al. discloses a golf ball having inner and outer cover layers made of ionomer to achieve high spin rates (See Abstract). In one embodiment, the inner cover comprises a high acid ionomer and the outer cover comprises a low acid ionomer (See Column 5, lines 14 through 35; and Column 15, lines 10 through 39). One having ordinary skill in the art would have found it obvious to have an inner cover made of a high acid ionomer and an outer cover made of a low acid ionomer, as taught by Sullivan et al., in order to improve the spin of the golf ball.

Claims 23, 24, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egashira et al. (USPN 5439227) in view of Sullivan et al. (USPN 5803831).

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Egashira et al. does not disclose the inner and outer cover layers of ionomer having 16% or greater acid content and/or 16% or less acid content. Sullivan et al. discloses a golf ball having inner and outer cover layers made of ionomer to achieve high spin rates (See Abstract). In one embodiment, the inner cover comprises a high acid ionomer and the outer cover comprises a low acid ionomer (See Column 5, lines 14 through 35; and Column 15, lines 10 through 39). One having ordinary skill in the art would have found it obvious to have an inner cover made of a high acid ionomer and an outer cover made of a low acid ionomer, as taught by Sullivan et al., in order to improve the spin of the golf ball.

Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (USPN 5688595) in view of Wu (USPN 5334673).

Yamagishi et al. discloses a golf ball having a core, comprising a structure of at least two layers, and a cover, comprising an inner and outer cover layer, surrounding the core (See Abstract). The core comprises an inner sphere and a surrounding layer wherein the surrounding layer may be a single layer or have a plurality of layers (See Column 3, lines 21 through 29). The inner sphere is made of polybutadiene, a diene containing rubber, inert fillers such as zinc oxide, barium sulfate, silica, calcium carbonate, and zinc carbonate, and has a diameter of 20 to 39mm, or 0.79 to 1.54 inches (See Column 4, lines 5 through 20 and paragraph bridging Columns 4 and 5). The surrounding layer(s) is made of ionomer resin or a rubber base material like the inner sphere and give the entire core a diameter of 35 to 41mm, 1.38 to 1.61 inches (See Column 4, lines 33 through 41). The inner and outer cover layers are made of

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ionomer resins and non-ionomer resins alone or in admixture (See Column 4, lines 1 through 4). Yamagishi et al. does not explicitly disclose the cover layer comprising polyurethane. Wu discloses a golf ball cover made of a thermoplastic polyurethane. The polyurethane is preferable over ionomer resin because it employs the cut resistance and low cost of that of ionomer resins but also provides the click and feel of that of a balata cover which the ionomer resin cannot provide. One having ordinary skill in the art would have found it obvious to create a cover using polyurethane instead of ionomer resin because it provide an additional click and feel characteristics which the ionomer resin cannot provide.

Allowable Subject Matter

Claim 31 is allowed.

Claims 10, 14, 22, 28, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

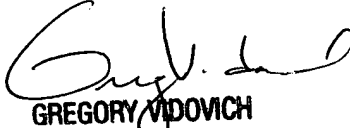
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Alvin A. Hunter, Jr.


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
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